DETAILED ACTION

Response to Amendment

1. The Applicant's Request for Reconsideration, filed 25 February 2008, has been received, entered into the record, and considered.

2. There were no amendments made to the claims. Claims 1-16 remain pending in the application.

The Invention

3. The claimed invention is a method for investigating intellectual property related to a reference piece of intellectual property. In one embodiment, the user inputs a trademark, and the system generates a list of patents and patent applications which are related in some way to said trademark.

Priority

4. The Applicant's claim to domestic priority under 35 U.S.C. § 119(e) based upon U.S. Provisional Patent Application 60/421,710, filed 28 October 2002, is acknowledged.

Drawings

5. The application includes informal (hand drawn) drawings. While these drawings are acceptable for examination purposes, the examiner encourages the Applicant to submit formal drawings at the earliest opportunity. Early submission of formal drawings will help expedite post-allowance processing and publication of the issued patent.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lee** (U.S. Patent 6,694,331) in view of **Ooishi** (U.S. Patent Application Publication 2002/0147793).

9. Regarding claim 1, **Lee** teaches a method for investigating intellectual property related to a user inputted reference piece of intellectual property as claimed, said method comprising:

a) providing a first database of discrete pieces of first intellectual property, said pieces of first intellectual property each including an associated set of first characteristics (see disclosure that the system supports the analysis of different types of intellectual property information, such as patents, trademarks, copyrights, trade secrets, etc., col. 1, lines 16-22; see also col. 10, lines 34-40; see also col. 11, line 63 through col. 12, line 7);

b) providing a second database of discrete pieces of second intellectual property, said second intellectual property being of a different type from said first

intellectual property, said pieces of second intellectual property being initially unassociated with said pieces of first intellectual property (see disclosure that the system supports the analysis of different types of intellectual property information, such as patents, trademarks, copyrights, trade secrets, etc., col. 1, lines 16-22; see also col. 10, lines 34-40; see also col. 11, line 63 through col. 12, line 7);

c) inputting, by a user, a reference piece of intellectual property (see disclosure that the user inputs data identifying select intellectual property information to form or otherwise designate the source grouping of intellectual property, col. 10, lines 40-45);

d) searching said first database to identify said pieces of first intellectual property having predetermined characteristics in common with the reference piece of intellectual property (see disclosure of the identification of a 'source grouping' of intellectual property information, col. 8, lines 17-28; see also designation of a 'source grouping', col. 10, lines 34-45);

e) developing without user input at least one query based on at least a portion of said first characteristics of said identified pieces of first intellectual property (see disclosure of the use of a source grouping to generate a list of 'different elements' found in the source grouping, col. 8, line 56 through col.

9, line 15; see also col. 10, line 61 through col. 11, line 39; see also col. 11, line 63 through col. 64, line 29);

f) searching said second database to identify said pieces of second intellectual property satisfying said at least one query (see disclosure that the created 'field of search' can be used as a search query to be executed by a local or remote database, col. 12, lines 26-29; see also disclosure that the invention can be used to variously search and/or analyze information related to any form of intellectual property, including patents and trademarks, col. 12, lines 30-42); and

g) transmitting information related to said identified pieces of second intellectual property to the user (see disclosure that other modules may be included that, among other things, output the results achieved through operation of the search server, col. 2, lines 7-11).

Lee does not explicitly teach a method wherein the second search is performed without input from the user.

Ooishi, however, teaches as prior art a method of searching a first database, and then without input from the user, generating a second query from the first search

results and applying said second query to a second database (see paragraphs [0006] and [0007]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to automate the process of generating secondary searches of additional databases, since this would automatically provide relevant search results from additional databases to the user without forcing the user to first confirm the subsequent search of the second database.

10. Regarding claim 2, **Lee** additionally teaches a method for investigating intellectual property wherein said pieces of first intellectual property are selected from the group consisting of registered trademarks, unregistered trademarks and applications to register trademarks (see disclosure that the invention can be used to variously search and/or analyze information related to any form of intellectual property, including patents and trademarks, col. 12, lines 30-42).

11. Regarding claims 3 and 5, **Lee** additionally teaches a method for investigating intellectual property wherein said pieces of second intellectual property are selected

from the group consisting of patents and patent applications (see disclosure that the invention can be used to variously search and/or analyze information related to any form of intellectual property, including patents and trademarks, col. 12, lines 30-42).

12. Regarding claims 4 and 6, **Lee** additionally teaches a method for investigating intellectual property wherein the reference piece of intellectual property is a trademark (see disclosure of the receipt of input data or signals from the user identifying select intellectual property to form a 'source grouping' of intellectual property information, col. 8, lines 17-28; see also the fact that the intellectual property information can include trademarks, col. 8, lines 11-17).

13. Regarding claim 7, **Lee** additionally teaches a method for investigating intellectual property wherein said step of searching said first database includes searching said first database to identify said pieces of first intellectual property which are identical matches to the reference piece of intellectual property (see disclosure that the select intellectual property information input by the user may be individual intellectual property identified by native indicia, which would include identifying trademarks which identically matched an input native indicia, col. 8, lines 30-34).

14. Regarding claim 8, **Lee** additionally teaches a method for investigating intellectual property wherein said step of searching said first database includes searching said first database to identify said pieces of first intellectual property which include at least one search term in common with at least a portion of the reference piece of intellectual property (see disclosure that the select intellectual property information input by the user may be individual intellectual property identified by native indicia, which would include identifying trademarks which have, for instance, a common assignee, col. 8, lines 30-34).

15. Regarding claim 9, **Lee** additionally teaches a method for investigating intellectual property further comprising sorting said identified pieces of first intellectual property (see disclosure of the sorting of search results, col. 4, lines 49-57 et seq.).

16. Regarding claim 10, **Lee** additionally teaches a method for investigating intellectual property wherein said step of sorting includes comparing each of said identified pieces of first intellectual property with the reference piece of intellectual property to determine degree of similarity therebetween (see disclosure of the sorting of search results based upon relevancy or weighted relevancy, col. 4, lines 49-57 et seq.).

17. Regarding claim 11, **Lee** additionally teaches a method for investigating intellectual property wherein said steps of developing at least one query and searching said second database are sequentially conducted for each identified piece of first intellectual property (see disclosure that each piece of intellectual property in the source grouping is reviewed in order to ascertain different elements to be used as search criteria, col. 8, lines 56-63; see also col. 10, line 61 through col. 11, line 2; see also col. 11, line 63 through col. 12, line 7; also note that for at least the cases where none or exactly one piece of first intellectual property is identified, the execution of said developing step and searching step is de facto sequential).

18. Regarding claim 12, **Lee** additionally teaches a method for investigating intellectual property wherein one of said first characteristics includes the name of the owner of the associated said piece of first intellectual property, and wherein said at least one query includes a first query, said first query being to identify all pieces of second intellectual property in which the owner of the respective said identified piece of first intellectual property has rights (see disclosure that the search engine performs searches based on input data such as Inventor and Assignee, col. 4, lines 15-29).

19. Regarding claim 13, **Lee** additionally teaches a method for investigating intellectual property wherein said first query being to identify all pieces of second intellectual property in which the owner of the respective said identified piece of intellectual property has recorded ownership rights (see disclosure that the search engine performs searches based on input data such as Inventor and Assignee, col. 4, lines 15-29).

20. Regarding claim 14, **Lee** additionally teaches a method for investigating intellectual property wherein one of said first characteristics includes the goods or services of the associated said piece of first intellectual property, and wherein said at least one query includes a second query, said second query being to identify all said pieces of second intellectual property which relate to the goods or services of the respective said identified piece of first intellectual property (see disclosure that the intellectual property can be searched based on classification, including the classification of goods and services for trademarks, col. 6, lines 35-56).

21. Regarding claim 15, **Lee** additionally teaches a method for investigating intellectual property wherein one of said first characteristics includes information relating to dates of first use of the associated said piece of first intellectual property, and

wherein said at least one query includes a third query, said third query being to identify all said pieces of second intellectual property having a filing date or priority date after the dates of first use of the respective said identified piece of first intellectual property (see disclosure that the search engine performs searches based on input data such as Publication Date, Filing Date, Related Data and Priority Data, col. 4, lines 15-29).

22. Regarding claim 16, **Lee** additionally teaches a method for investigating intellectual property wherein one of said first characteristics includes a classification of the associated said piece of first intellectual property, and wherein said at least one query includes a fourth query, said fourth query being to identify all said pieces of second intellectual property having a classification equivalent to the classification of the respective said identified piece of first intellectual property (see disclosure that the search engine performs searches based on input data such as International Classification, U.S. Classification, and Cross-Reference Classification, col. 4, lines 15-29).

Response to Arguments

23. Applicant's arguments filed 25 February 2008 have been fully considered but they are not persuasive.

24. Regarding the argument that the combination of the **Ooishi** and **Lee** references is improper since it would change the principle of operation of the invention disclosed by **Lee**, the examiner respectfully disagrees.

As disclosed in the **Lee** reference at col. 10, line 34 through col. 12, line 29, the Field-of-Search Module accepts input data from a user which identifies intellectual property information of interest [the source grouping], retrieves the intellectual property information of interest, analyzes the retrieved intellectual property information to extract elements, such as words, phrases, concepts, etc. [search information], and uses the extracted elements as a search query to be submitted to a local or remote database.

There are a number of embodiments disclosed by the reference. In one embodiment (disclosed in column 11), the extracted search information can be stored for later use of immediately output to the user.

> Where desired, the list thus generated may be stored for later use or immediately output to the user (e.g., via network **37** to user interface **35**) for viewing, display or other use by the user (e.g., storing in a local/remote memory unit, printing, forwarding, etc.).

It is further disclosed that the user may use the displayed search information as an aid in determining, preparing, formulating or otherwise creating a field-of-search.

> A user presented with a list of such search information (or other useable output) from Field-of-Search Module **314** may use the list as an aid in determining, preparing, formulating, or otherwise creating a field-of-search (or any other practical use).

In one embodiment, discussed beginning at col. 11, line 63, the user selects one or more source groupings to be used as a basis for determining a field-of-search. The source grouping is analyzed and elements, such as words, phrases and concepts, are extracted as search information.

At col. 12, lines 17-19, it is disclosed that

> The search information may be displayed or otherwise output for viewing by the user to assist in the creation of a field-of-search (step **708**).

The use of the 'may be' language renders the display step an optional one.

> Where desired, the search information may be statistically analyzed for use in automatically generating, adding, or suggesting a field-of-search. As illustrated in FIG. **5**, for example, search information that has a frequency of appearance in the selected source grouping that is greater than a predetermined frequency value may be automatically added to the field-of-search created (step **709**). As used in a search system, as one example, the field-of-search thus created can form (or be part of) a search query or criteria to be executed by a local or remote database.

Note the disclosure that the field-of-search derived from the user-selected search grouping(s) can be automatically generated, and also the disclosure that "the field-of-search thus created *can form* a search query or criteria to be executed by a local or remote database." If the field-of-search can *form* a search query, then user interaction is not required in its generation.

This disclosure clearly suggests an embodiment where the user selected source grouping(s) are used to automatically construct a field-of-search and submitting it, without user's involvement, as search criteria to a local or remote database.

In light of this disclosure, the examiner believes that incorporating the explicitly disclosed feature of applying search results as a second query without user interaction of the **Ooishi** reference to the system disclosed in the **Lee** reference would not change the principal of operation of the system, and thus the combination is proper.

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119, or sent via email at luke.wassum@uspto.gov, **with a previous written authorization in accordance with the provisions of MPEP § 502.03.** Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Luke S. Wassum/
Primary Examiner
Art Unit 2167

lsw
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